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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,709	03/10/2004	Roberto Licon	24207-01000	6170

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EXAMINER

KIM, PAUL

ART UNIT PAPER NUMBER

2161

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/798,709	Applicant(s) LICON ET AL.	
	Examiner Paul Kim	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
**SAM RIMELL**  
**PRIMARY EXAMINER**

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>22 March 2004</u> . | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1. This Office action is responsive to the following communication: Continuation application filed on 10 March 2004.
2. Claims 1-8 are pending and present for examination. Claims 1 and 5 are independent.

#### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claim 1 rejected on the ground of nonstatutory double patenting over claim 1 of U. S. Patent No. 6,728,705 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a system and method for selecting content for displaying over the internet based upon some user input.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1-2 and 5-6** are rejected under 35 U.S.C. 102(e) as being anticipated by Horowitz et al (U.S. patent No. 6,236,987, hereinafter referred to as HOROWITZ), filed on 3 April 1998, and issued on 22 May 2001.

7. **As per independent claim 1**, HOROWITZ teaches:

A method for displaying information comprising:

generating a plurality of content modules, each content module comprising a subset of the content of a web site {See HOROWITZ, C8:L15-21, wherein this reads over " The user interface module 110 is responsible for providing a user interface to the information retrieval system 100 including receiving user input queries and displaying query results, including a resulting topic arrangement 162 of topics and documents

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resulting from the processing and analysis of a current query on the display device 109 of the computer system.”};

storing the content modules in a content module data directory {See HOROWITZ, C9:L6-9, wherein this reads over “each document has an association with at least one topic in the knowledge base, and preferably with many topics”};

maintaining a database of subject category identifiers, each subject category identifier corresponding to at least one content module in the content module data directory {See HOROWITZ, C9:L1-5, wherein this reads over “these items of meta-data may themselves be references to topics in the knowledge base, so that they may be used by the dynamic content organization module to create various topic arrangements”; and C9:L16-22, wherein this reads over “[a]n implementation of the document collection may store the document-topic associations in a document-topic table, . . . where TopicList is a list of topics”};

receiving a query from a user {See HOROWITZ, C8:L15-21, wherein this reads over “ The user interface module 110 is responsible for providing a user interface to the information retrieval system 100 including receiving user input queries and displaying query results, including a resulting topic arrangement 162 of topics and documents resulting from the processing and analysis of a current query on the display device 109 of the computer system.”};

retrieving a plurality of URL's of web sites containing content pertaining to the query {See HOROWITZ, C8:L15-21, wherein this reads over “ The user interface module 110 is responsible for providing a user interface to the information retrieval system 100 including receiving user input queries and displaying query results, including a resulting topic arrangement 162 of topics and documents resulting from the processing and analysis of a current query on the display device 109 of the computer system.”};

matching the query to at least one subject category identifier {See HOROWITZ, C8:L15-21, wherein this reads over “ The user interface module 110 is responsible for providing a user interface to the information retrieval system 100 including receiving user input queries and displaying query results, including a resulting topic arrangement 162 of topics and documents resulting from the processing and analysis of a current query on the display device 109 of the computer system.”};

obtaining the at least one content module from the content module directory associated with the subject category identifier {See HOROWITZ, C8:L15-21, wherein this reads over “ The user interface module 110 is responsible for providing a user interface to the information retrieval system 100 including receiving user input queries and displaying query results, including a resulting topic arrangement 162 of topics and documents resulting from the processing and analysis of a current query on the display device 109 of the computer system.”}; and

displaying information relating to the plurality of retrieved web sites and information from said at least one content module on a display screen to the user {See HOROWITZ, C8:L15-21, wherein this reads over “ The user interface module 110 is responsible for providing a user interface to the information retrieval system 100 including receiving user input queries and displaying query results, including a resulting topic arrangement 162 of topics and documents resulting from the processing and analysis of a current query on the display device 109 of the computer system.”}.

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**8. As per dependent claims 2 and 6, HOROWITZ teaches:**

A method according to claim 1 wherein said information is displayed on the first and second regions of the display screen in response to a single input from the user {See HOROWITZ, Figures 4, 5A-D, 6A-D and 7A-B}.

**9. As per independent claim 5, HOROWITZ teaches:**

A method for displaying information from the Internet comprising:

generating a plurality of content modules, each content module comprising a subset of the content of at least one web site {See HOROWITZ, C8:L15-21, wherein this reads over "The user interface module 110 is responsible for providing a user interface to the information retrieval system 100 including receiving user input queries and displaying query results, including a resulting topic arrangement 162 of topics and documents resulting from the processing and analysis of a current query on the display device 109 of the computer system."};

storing the content modules in a content module data directory {See HOROWITZ, C9:L6-9, wherein this reads over "each document has an association with at least one topic in the knowledge base, and preferably with many topics"};

receiving a query from a user {See HOROWITZ, C8:L15-21, wherein this reads over "The user interface module 110 is responsible for providing a user interface to the information retrieval system 100 including receiving user input queries and displaying query results, including a resulting topic arrangement 162 of topics and documents resulting from the processing and analysis of a current query on the display device 109 of the computer system."};

assigning the query to at least one content module {See HOROWITZ, C2:L45-49, wherein this reads over "a combination of topic and full text retrieval. In these systems, a full text query is processed to identify various topics in the topic hierarchy that match the query, or portions of it, and these topics and their documents are displayed to the user"; and C3:L48-51, wherein this reads over "[a] supertopic arrangement is a selection of the parent or grandparent topics of the topics of the current query which best generalize the document set resulting from the current query"};

displaying on a first region of the user's display screen, a list of information relating to the plurality of retrieved web sites {See HOROWITZ, Figures 4, 5A-D, 6A-D and 7A-B}; and

displaying on a second region of said display screen, information from said at least one content module associated with the query {See HOROWITZ, Figures 4, 5A-D, 6A-D and 7A-B}.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time

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the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. **Claims 3-4 and 7-8** are rejected under 35 U.S.C. 103(a) as being unpatentable over HOROWITZ, in view of Official Notice.

12. **As per dependent claims 3 and 7**, HOROWITZ, in combination with Official Notice, discloses:

A method according to claim 1 wherein the content module directory comprises a data structure having nodes {See HOROWITZ, C3:L66-C4:L8, wherein this reads over "[a] subtopic arrangement is the converse of the supertopic arrangement, and is a selection of those child or grandchildren topics of the topics associated with the current document set that together provide the best coverage of, and distinction (partitioning) over the current document set returned from the query. Like a supertopic arrangement, a subtopic arrangement will compress the topic hierarchy by excluding intermediate child topics, and selecting the lowest level child topics that best cover and partition the current document set"}, and wherein each node is associated with one or more key numbers.

It would have been obvious to one of ordinary skill in the art at the time the invention was created to associate nodes of a data structure with key numbers such that the key numbers may be used as identification markers to associate the nodes in the data directory.

13. **As per dependent claims 4 and 8**, HOROWITZ, in combination with Official Notice, discloses:

A method according to claim 1 wherein some of said content modules include functional devices.

It would have been obvious to one of ordinary skill in the art at the time the invention was created to have functional programs or devices (e.g. powerpoint files or streaming media) included within the content of the content modules.

### ***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Kim whose telephone number is (571) 272-2737. The examiner can normally be reached on M-F, 9am - 5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christian Chase can be reached on (571) 272-4190. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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**SAM RIMELL**  
**PRIMARY EXAMINER**